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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/457,842

Applicant(s)

SAWADA ET AL.

Examiner

Cristina O Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 January 2004 has been entered.
2. Claims 1-3, 10 and 13 have been amended. Claims 9 and 17-19 have been canceled. Claims 1-8, 10-16 and 20-23 are pending in this case.

Response to Arguments

3. Applicant's arguments with respect to claims 1-8, 10-16 and 20-23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

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6. Regarding claim 1 –

Downs discloses a data charging system comprising a content generator for generating contents containing object data, a charge recording medium for recording the charging data used for charging for said object data and the recognition data used for recognition of the object data in said contents, and a data charging apparatus for charging for the use of said object data by using said charging data and said recognition data recorded; wherein said data charging apparatus comprises data reading logic for reading said recognition data and said charging data from said recording medium, a separator for separating said object data from said contents, an recognition logic for recognizing said separated object data by using said recognition data read out, an accounting logic for charging for the use of said recognized object data by using said charging data read out, and a writing logic for writing, as said charging data, the results of charging for the use of said recognized object data into said recording medium (e.g. col 8 ln 7-15, col 3 ln 40-56, col 7 ln 40-55).

7. Regarding claim 20 –

Downs discloses a data charging system according to claim 1, wherein the content generator generated a digital watermark embedded in said contents (e.g. col 7 ln 55-65).

8. Regarding claim 21 –

Downs discloses a data charging system according to claim 20, wherein the content generator generates watermark information about the digital watermark and also embedded in said contents (e.g. col 7 ln 56-col 8 ln 5).

9. Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

Downs discloses a content generator for embedding digital watermarks in object data and generating contents in a data charging system which records, on a charge recording medium, the charging data used for charging for object data contained in said contents and the recognition data used for recognizing the object data in said contents and charges only for the use of the object data embedded with said digital watermarks by using said charging data and said recognition data recorded (e.g. col 7 ln 56-col 8 ln 5).

10. Claims 3-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

11. Regarding claim 3 –

Downs discloses a data charging system which records, on a charge recording medium, the charging data used for charging for object data contained in said contents and the recognition data used for recognizing the object data in said contents charges for the use of said object data by using said charging data and said recognition data recorded, a data charging apparatus comprising: a data reading logic for reading said recognition data and said charging data from said recording medium, a separator for separating said object data from said contents, an recognition logic for recognizing said separated object data by using said recognition data read out, an accounting logic for charging for the use of said recognized object data by using said charging data read out, and a

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writing logic for writing, as said charging data, the results of charging for the use of said recognized object data into said recording medium (e.g. col 11 ln 1-28).

12. Regarding claim 4 –

Downs discloses the data charging apparatus according to Claim 3, wherein said contents comprise said object data and said recognition data for recognizing this object data, said separator separates said object data and said recognition data from said contents, said recognition logic recognizes said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium, and said accounting logic charges for said object data by using said charging data read out (e.g. col 7 ln 56-col 8 ln 5).

13. Regarding claim 5 –

Downs discloses the data charging apparatus according to Claim 3, further comprising a watermarking logic for embedding digital watermarks in said object data separated from said contents, wherein said separator separates said object data and said recognition data from said recognition logic recognizes said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium, and said accounting logic charges for said object data embedded with said digital watermarks (e.g. col 7 ln 40-65).

14. Regarding claim 6 –

Downs discloses the data charging apparatus according to Claim 3, wherein a digital watermark is embedded in said object data in said contents, said data charging apparatus further comprising a means for detecting if said object data is embedded with

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said digital watermark, said separator separating said object data and said recognition data from said contents, said recognition logic recognizing said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium, and said accounting logic charging for said object data only if said object data is found to be embedded with said digital watermark (e.g. col 7 In 56-col 8 In 5).

15. Regarding claim 7 –

Downs discloses the data charging apparatus according to Claim 3, wherein said charging data recorded on said recording medium contains at least payment data which indicates the payment made in advance for the use of said object data, and said accounting logic charges for the use of said object data within the limits of the amount indicated by said payment data contained in said charging data (e.g. col 8 In 6-15).

16. Regarding claim 8 –

Downs discloses the data charging apparatus according to Claim 7, wherein said charging data recorded on said recording medium further contains unit price data representing the accounting unit for the use of said object data and the price corresponding to the accounting unit, said data charging apparatus comprising an accounting unit detection logic for detecting unit accounting amount data which represents the amount of said accounting unit for the object data separated from said contents, said accounting logic charging within the limits of the amount indicated by said payment data, based on said unit price data contained in said charging data read out and on the unit accounting amount data detected (e.g. col 11 In 15-28).

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17. Claims 10-12 and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

18. Regarding claim 10 –

Downs discloses a data charging method for generating contents which contain object data and recognition data used for the recognition of this object data in the generated contents, recording, in a charge recording medium, the charging data used for charging for said object data and the recognition data used for recognition of the object data, and charging for the use of said object data by using said charging data and said recognition data recorded, comprising the steps of reading said recognition data and said charging data from said recording medium, separating said object data from said contents, recognizing said separated object data by using said recognition data read out, charging for the use of said recognized object data by using said charging data read out; and writing, as said charging data, the results of charging for the use of said recognized object data into said recording medium (e.g. col 10 ln 50 – col 11 ln 28).

19. Regarding claim 11 –

Downs discloses a data charging method according to Claim 10, wherein said object data in said contents are embedded with digital watermarks, comprising the steps of separating said object data and said recognition data from said contents; recognizing said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium; detecting said digital watermark embedded in said object data; and charging for said recognized object data

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only by using said charging data read out if said object data is found to be embedded with said digital watermark (e.g. col 7 ln 56-col 8 ln 5).

20. Regarding claim 12 –

Downs discloses a data charging method according to Claim 10, comprising the steps of separating said object data and said recognition data from said contents recognizing said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium; embedding digital watermarks in said separated object data; and charging for the use of the object data embedded with said digital watermarks by using said charging data read out (e.g. col 7 ln 56-col 8 ln 5).

21. Regarding claim 22 –

Downs discloses a method according to claim 11 further comprising the step of embedding in said contents information about the digital watermark (e.g. col 8 ln 1-5)

22. Regarding claim 23 –

Downs discloses a method according to claim 22 wherein the embedding step includes the step of embedding in said contents instructions for embedding the contents with said digital watermarks (e.g. col 7 ln 56-col 8 ln 5).

23. Claims 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

24. Regarding claim 13 –

Downs discloses a data charging apparatus of a data charging system which records, on a charge recording medium, the charging data used for charging for the object data

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contained in contents and the recognition data used for recognition of the object data in said contents, and charges for the use of said object data by using said charging data and said recognition data recorded; a computer program product enabling a computer to execute the steps of reading said recognition data and said charging data from the recording medium, separating said object data from said contents, recognizing said separated object data by using said recognition data read out, charging for the use of said recognized object data by using said charging data read out, and writing, as said charging data, the results of charging for the use of said recognized object data into said recording medium (e.g. col 11 ln 1-28).

25. Regarding claim 14 –

Downs discloses the computer program product according to Claim 13, wherein said contents contain said object data and said recognition data used for recognition of the object data, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data separated from said contents and on said recognition data read out from the recording medium, and a charge is made for said object data in said charging step by using said charging data read out (e.g. col 11 ln 1-28).

26. Regarding claim 15 –

Downs discloses the computer program product according to Claim 13, wherein the computer is made to execute the step of embedding digital watermarks in said object data separated from said contents, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in

said recognition step, based on said recognition data separated from said contents and on said recognition data read out from the recording medium, and a charge is made for said object data embedded with said digital watermarks in said charging step (e.g. col 7 In 56-col 8 In 5).

27. Regarding claim 16 –

Downs discloses the computer program product according to Claim 13, wherein said object data in said contents are embedded with digital watermarks, the computer is further made to execute the step of detecting that said object data is embedded with said digital watermarks, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data separated from said contents and on said recognition data read out from the recording medium, and a charge is made for said object data in said charging step only if said object data is found to be embedded with said digital watermark (e.g. col 7 In 56-col 8 In 5).

28. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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